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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/693,690	10/20/2000	Kia Silverbrook	NPA064US	8647
24011 7590 04/19/2007 SILVERBROOK RESEARCH PTY LTD 393 DARLING STREET BALMAIN, 2041 AUSTRALIA			EXAMINER PORTER, RACHEL L	
			ART UNIT	PAPER NUMBER
			3626	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/19/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

09/693,690

Applicant(s)

SILVERBROOK ET AL

Examiner

Rachel L. Porter

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 January 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5,8-31 and 34-44 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5,8-31, and 34-44 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---------------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>11/20/06</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Notice to Applicant

1. This communication is in response to the Applicant's response filed 1/8/07. Claims 1-5,8-31, and 34-44 are pending.

Continued Examination Under 37 CFR 1.114

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 9/25/06 has been entered.

Information Disclosure Statement

3. The information disclosure statement filed 11/20/06 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each cited foreign patent document; each non-patent literature publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the information referred to therein has not been considered.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1-5,8-31, and 34-44 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

6. Claims 1 and 27 recites "the form" throughout the body of the claim. There is insufficient antecedent basis for this limitation.

The Examiner suggests consistent use of the phrase the or said "paper form" throughout the body of the claim.

Claims 1-5, and 8-26 and claims 28-31 and 34-44 inherit the deficiencies of claim 1 and claim 27 through dependency from their respective independent claims, and are therefore also rejected.

It is noted that claims 1 and 27 have been amended. However, these amendments do not overcome the 112, 2nd rejections previously set forth. The steps/functions performed in method and by the sensing device remain unclear to the Examiner. For example, in claim 1, the preamble is detailed regarding the contents of the form (i.e. plurality of tags, each tag containing ...), but this detail and descriptive material does not clearly connect to the steps are being performed. While reading claim 1, it would appear that only 2 steps are performed: 1) receiving in a computer system indicating data from a sensing device regarding the identity of the form and a position of the sensing device relative to the form; and 2) identifying, in the computer system and from the indicating data, at least one parameter relating to insurance.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1-5, 8-31, and 34-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Montagna et al (USPN 4,899,292) and in view of Luchs (USPN 4,831,526).

As per claims 1-5 and 8-26, Montagna teaches a method for using a computer system including a sensing device to receive and input information onto a form containing a plurality of tags. (col. 5, lines 22-36; Figure 2 (ref. 41); col. 8, lines 1-6). The tags (which may be part of a hyper page) allow information to be placed in a particular location on the form. Moreover, the touch screen feature of the system (col. 8, lines 8-46), allows the sensing device to input data in the encoded sections of the forms relative to the location tags.

Montagna further discloses a system and method wherein the position of the sensing device relative to physical media/document is recorded (xy coordinates) and stored within the computer system (Figure 11, (col. 11, lines 27-44)

Montagna discloses further discloses capturing information related to the field of insurance, but does not expressly disclose the invention as it relates to printing and identifying information on forms related to specific types of insurance services.

Luchs teaches a method wherein forms relating to insurance services are generated. (Figures 1, 2E-2F; col. 14, lines 46-15; col. 17, line 31-col.18, line 10) Luchs further discloses a method in which customer data, quote information, insurance policy type, deductible, and claim information may be included as parameters on the insurance forms. (Tables in col. 7-8). At the time of the Applicant's invention, it would have been obvious to one of ordinary skill in the art to modify the method of Montagna with the teaching of Luchs to use a computer system with sensing devices to gather information from forms related to various types of insurance services. One would have been motivated to include these features to provide an automated system which properly positions information on regarding various insurance services into the appropriate forms, thereby minimizing the need for repetitive entry of insurance data for each insurance application (See Luchs: col. 2, lines 6-18) and producing documents that are tailored to an individual client (See Luchs: col. 2, lines 21-25).

As per claims 27-31, and 34-44, Montagna teaches a computer system including a sensing device to receive and input information onto a form containing a plurality of tags. (col. 5, lines 22-36; Figure 2 (ref. 41); col. 8, lines 1-6). The tags (which may be part of a hyper page) allow information to be placed in a particular location on the form. Moreover, the touch screen feature of the system (col. 8, lines 8-46), allows the sensing device to input data in the encoded sections of the forms relative to the location tags.

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Montagna further discloses a system and method wherein the position of the sensing device relative to physical media/document is record (xy coordinates) and stored within the computer system (Figure 11, (col. 11, lines 27-44)

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Response to Arguments

9. Applicant's arguments filed on 9/25/06 have been fully considered but they are not persuasive.

(A) Applicant argues the applicants' invention refers only to a paper form while Montagna is electronic forms.

In response to applicant's arguments, the recitation of details regarding form (e.g. paper form) has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

As explained in the 112,2nd paragraph rejection, it is noted that the applicant provides detail regarding "the form" in the preamble of claims 1 and 27. However, in exemplary claim 1, the claim language fails to recite steps, which tie the structural detail (e.g. the form with a plurality of tags into the claimed method)

Furthermore, the Examiner respectfully submits that interactive printed forms may include but are not limited to paper and electronic/touch-screen forms. The Applicants' specification discloses a preferred embodiment wherein information is filled in "electronically" using such interactive forms (page 8, lines 11-21). It is not clear to the examiner that the use of "paper forms" presents a patentable distinction over, when

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the only functions performed in the claimed method are the scanning of a form for tags and capturing data relating to an insurance parameter.

Montagna discloses a system and method wherein the position of the sensing device relative to physical media/document is received (xy coordinates) and stored within the computer system (Figure 11, (col. 11, lines 27-44) Montagna discloses further discloses capturing information related to the field of insurance.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

- Landrum et al (4,616,854) discloses an insurance form indicia system, which provides data on different insurance parameters.
- Sekendur (5,477,012) discloses a system for detecting the position of moveable sensor relative to space encoded with coordinate information.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rachel L. Porter whose telephone number is (571) 272-6775. The examiner can normally be reached on M-F, 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on (571) 272-6776. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

RP
RP

Carolyn Block
Patent Examiner-3626
4/16/07